I.

Support for the Amendment

The amendment of claim 1 is supported at least at page 4, lines 16-20 of the specification. The amendment does not introduce new matter into the specification.

II.

The Rejections

The only issue presented in the Office Action of December 21, 1998, which is the most recent Office Action received in the connection with the present application, is whether claims 1-33 and 40-42 are obvious over Snodgrass *et al.*, (U.S. Patent No. 5,643,748) under 35 U.S.C. §. 103(a).

Claims 40-42 have been cancelled, without prejudice, by the present Preliminary Amendment. The remaining claims (claims 1-33) are believed to be clearly patentable over Snodgrass *et al.*

The claims, as currently amended, concern agonist antibodies that are capable of decreasing body weight or fat-depot weight or food intake in an obese animal. Snodgrass *et al.* disclose a partial clone encoding a receptor (Hu-B1.219) that is identified as a novel member of the hematopoietin receptor family. Snodgrass *et al.* also note that, while the "nucleotide sequence of this clone shares certain homology with other HR genes, it is also unique in structure" (colum 2, lines 49-52). Based upon its expression in certain human fetal and tumor cells, Hu-B1.219 is described as potentially useful in the diagnosis of cancer or marking of fetal tissues (column 2, lines 55-58). Hu-B1.219 is further described as useful in screening for antibodies, peptides, or other ligands that act as agonists or antagonists of the Hu-B1.219 receptor (column 10, lines 19-23). In view of the disclosure concerning the potential biological activities of the receptor, the fair reading of the suggestion in Snodgrass *et al.* to screen for agonist antibodies, is that such antibodies, if successfully made, would mimic the biological activities of Hu-B1.219, i.e. might find utility in the diagnosis of cancer or marking fetal tissues. Indeed, this utility for antibodies in general is suggested in the first paragraph of column 12. However, as noted at the bottom of column 11 that "[n]eutralizing antibodies, i.e., those which compete for the ligand binding site of the receptor are especially preferred for diagnostics and

therapeutics." Accordingly, Snodgrass *et al.* are less than clear about the biological activity or utility of anti-Hu-B1.219 agonist antibodies. There is nothing in Snodgrass *et al.* that would state, suggest or imply any involvement of the Hu-B1.219 receptor in obesity. Therefore, a person skilled in the art reading the disclosure of Snodgrass *et al.* would have absolutely no motivation to screen for agonist anti-Hu-B1.219 antibodies that decrease body weight or fat-depot weight or food intake in an obese animal.

Even if it is assumed arguendo that Hu-B1.219 and agonist antibodies specifically binding to Hu-B1.219 inherently have the properties now specified in claim 1 and the claims dependent thereon, arguments based on "inherent" properties cannot stand when no supporting teaching exists in the prior art. Inherency and obviousness are distinct concepts, and obviousness rejections based upon what may be inherent in the prior art are improper. See, e.g. Koster Speedsteel v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 71 (Fed. Cir. 1986); *In re* Adams, 356 F.2d 998, 148 U.S.P.Q. 742 (CCPA 1966); *In re* Spormann, 363 F.2d 444, 150 U.S.P.Q. 449 (CCPA 1966).

In view of the foregoing arguments, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-33. As the application is believed to be in *prima facie* condition for allowance, an early action to that effect is respectfully solicited.

Respectfully submitted,

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